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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Paul Clinton Coffin

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Intellectual Property Administration

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EXAMINER

TRAN, HANH VAN

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/938,159	Applicant(s) COFFIN ET AL.	
	Examiner Hanh V. Tran	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22,24-29 and 35-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,22,24-29 and 35-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Upon further consideration, the Final Rejection of 2/25/2005 is hereby withdrawn.

The following is a Non-Final rejection. Any inconvenience is regretted.

2. Applicant's arguments, see the Appeal Brief, filed 2/16/2006, with respect to the rejection(s) of claim(s) 27, 40 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of USP 5,537,371 to Niederlein et al and USP 6,648,428 to Chaloner et al.

3. The indicated allowability of claims 43-53 is withdrawn in view of the newly discovered reference(s) to USP 6,648,428 to Chaloner et al, and USP 6,643,091 to Coffin et al. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 21-22, 25-26, 28, 35-37, 39, 41, and 57-59 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,537,371 to Niederlein et al.

Niederlein et al discloses a data storage system comprising all the elements recited in the above listed claims including, such as shown in Figs 1-3, a data storage system housing 2 having an opening, first and second elongate reference rails 11, Fig 3, located adjacent the opening, a plurality of media storage devices 3 each having a

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housing movable between a storage position within the data storage system and an extended position, the housing having a top, a bottom and opposing ends, first and second elongate alignment grooves 14 adapted to slidably engage with the first and second elongate reference rails 11 of the data storage system housing, a locking plate 22,23 attached to the housing and configured to engage a locking mechanism located in the opening in the data storage system, a handle/means for applying a force 31 operationally attached to the housing, a side portion of the housing having a plurality of slots configured to receive the data media 1, a plurality of dividers positioned in spaced-apart relation within the housing, wherein the media storage device may be inserted into and removed from the data storage system housing by slidably engaging the elongate reference rails and the elongate alignment grooves and guiding the media storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing, the opposing ends of the media storage device housing being located along the longitudinal axis, the data media being inserted into and removed from the media storage device housing along an axis transverse to the longitudinal axis. Further, it is well known that a data storage system would include a data exchange device for reading data from the data media, and a media handling system for transferring data media from the media storage device to the data exchange device.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 21-26, 28, 35-39, 41, 43-46, 50-52, and 55-62 are rejected under 35

U.S.C. 102(e) as being anticipated by USP 6,648,428 to Chaloner et al.

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Chaloner et al discloses a data storage system comprising all the elements recited in the above listed claims including, such as shown in Figs 1-2, a data storage system housing 70 having an opening, first and second elongate reference rails 272,274, Fig 7, located adjacent the opening, a plurality of media storage devices 30,32 each having a housing movable between a storage position within the data storage system and an extended position, the housing having a top, a bottom and opposing ends, first and second elongate alignment grooves 276,278 adapted to slidably engage with the first and second elongate reference rails 272,274, Fig 21, of the data storage system housing, a locking plate attached to the housing and configured to engage a locking mechanism located in the opening in the data storage system, a handle operationally attached to the housing, a side portion of the housing having a plurality of

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slots configured to receive the data media, a plurality of dividers positioned in spaced-apart relation within the housing, supplemental slots (defined as the spaced between plate 124 and the front 62) separate from the media storage device, means for applying a force, guide rails 36, Figs 7-8, to enable movement of the drawer between the retracted and extended positions, wherein the media storage device may be inserted into and removed from the data storage system housing by slidably engaging the elongate reference rails and the elongate alignment grooves and guiding the media storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing, the opposing ends of the media storage device housing being located along the longitudinal axis, the data media being inserted into and removed from the media storage device housing along an axis transverse to the longitudinal axis. Further, it is well known that a data storage system would include a data exchange device for reading data from the data media, and a media handling system for transferring data media from the media storage device to the data exchange device.

8. Claim 47 is rejected under 35 U.S.C. 102(e) as being anticipated by USP 6,643,091 to Coffin et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Coffin et al discloses all the elements recited in the above listed claim including a data storage system housing, a media storage device, a moveable drawer 16, and an automated drive system adapted to move the drawer 16 between a retracted position to an extended position (col. 14, lines 1-67.)

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 27, 29, 40, 42 are rejected under 35 U.S.C. 103(a) as being obvious over Chaloner et al in view of USP 6,042,2205 to Coffin et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an

invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Chaloner et al discloses all the elements as discussed above except for a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage the data media.

Coffin '205 teaches the idea of providing a media storage device housing with a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage the data media for the purpose securing the data media within the media storage device housing. Therefore, it would have been obvious to modify the structure of Chaloner et al by providing a spring mechanism comprising a first end and a second end, the first

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end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage the data media for the purpose securing the data media within the media storage device housing, as taught by Coffin et al, since both teach alternate conventional media storage device, used for the same intended purpose, thereby providing structure as claimed.

12. Claims 48-49 are rejected under 35 U.S.C. 103(a) as being obvious over Coffin et al '091.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under

35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Coffin et al '091 discloses all the elements as discussed above except for the drive system has a motor to cause movement of the drawer, wherein the drive system has a drive gear driven by the motor. Using a motor and drive gear as components of an automated drive system is well known in the art for the purpose of facilitating retraction and extension of a member. Therefore, it would have been obvious and well within the level of one skill in the art to modify the structure of Coffin et al '091 by providing the drive system with a motor and a drive gear driven by the motor for the purpose/motivation of facilitating retraction and extension of the drawer.

13. Claims 53-54 are rejected under 35 U.S.C. 103(a) as being obvious over Chaloner et al in view of USP 6,116,063 to Foslien et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer

in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Chaloner et al discloses all the elements as discussed above except for the media storage devices stacked in a vertical stack arrangement.

Foslien et al teaches the idea of stacking a plurality of media storage devices in a vertical stack arrangement for the purpose of allowing easy access to a plurality of media storage devices. Therefore, it would have been obvious to modify the structure of Chaloner et al by providing a plurality of media storage devices stacking in a vertical stack arrangement for the purpose of allowing easy access to a plurality of media storage devices, as taught by Foslien et al, since both teach alternate conventional data storage system, used for the same intended purpose, thereby providing structure as claimed.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (571) 272-6868. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVT *HVT*
April 28, 2006

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

